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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/560,125

04/12/2006

Stefan Henneck

10191/4174

2741

26646 7590 07/28/2009

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EXAMINER

NGUYEN, VU ANH

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/560,125

Applicant(s)

HENNECK ET AL.

Examiner

Vu Nguyen

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 17-36.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/David Wu/
Supervisory Patent Examiner, Art Unit 1796

/Vu Nguyen/
Examiner, Art Unit 1796

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons set forth in previous Office actions and because of the following reasons. First, the proposed amendment to claims 28-31 fails to overcome the rejection of these claims under 35 U.S.C. 112, second paragraph. The applicant argues that the ratios recited in these claims are not ambiguous because "the concentration of the solution" has been defined in the Specification as 0.5-2.0 wt% (Remarks, p. 5). It is not clear whether it is dispersing agent solution or binder solution that is being referred to as "the solution" by the applicant. In the Specification (p. 6, lines 1-17), it is disclosed that the amounts of the dispersing agents added to the ceramic powder should be such that their active ingredients are 0.5-2.0 wt% relative to the ceramic powder. Thus, the range of 0.5-2.0 wt% is not the concentration of the dispersing agent solution. In short, it makes little sense to say mixing certain amount of one solution to certain amount of another solution (or dispersion or a powder) when the concentration of the solution(s) is not known. Second, the applicant insists that "it is clear...that claim 17 does in fact recite preparing a second dispersion by homogenizing the first dispersion with a binder solution, which contains components of a ceramic powder." (Remarks, p. 6). However, the binder solution of claim 17 does not contain ceramic powder; it contains a solvent mixture, a copolymer, and a softener. Third, the applicant alleges that all the prior art-based rejections of the claims are improper because "[n]owhere does Osaka et al. teach, or suggest, preparing a second dispersion by homogenizing the first dispersion with a binder solution which contains components of a ceramic powder, one or more dispersing agents, an organic acid, at least one acrylatemethacrylate copolymer as the binder and at least one softener" and the secondary references do not cure such deficiency (Remarks, pages 6-8). Claim 17 recites a method comprising mixing a dispersing agent dispersion with a binder solution, wherein the dispersing agent dispersion contains ceramic powder, dispersing agent, organic acid, and solvent mixture, and wherein the binder solution contains an acrylatemethacrylate copolymer as the binder, solvent mixture, and a softener. Osaka's method comprises mixing a dispersing agent dispersion with a binder solution, wherein the dispersing agent dispersion contains ceramic powder, dispersing agent and solvent mixture, and wherein the binder solution contains an acrylatemethacrylate copolymeric binder, a solvent, and a plasticizer (or softener). Clearly, the prior art method reads on the claimed method with the only exception being that the prior art method lacks an organic acid, which is readily remedied by the cited secondary references. Finally, the applicant insists that the examiner has not provided sufficient specificity to support the contention that the DEPA document is available as prior art against the present application (p. 9). On the website www.mst.dk/English, under the Publications link, it is clearly indicated that the cited DEPA document was published in 2001. A copy of said web page is herein attached.